

**APPELLANT'S PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Application No. 10/782,547

Pre-Appeal Brief dated June 8, 2006

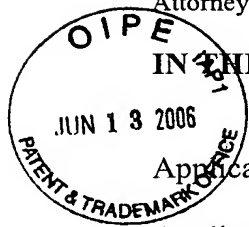
Reply to final Office Action dated February 13, 2006

Attorney Docket No. 4262-031383

**Response Under 37 CFR 1.116**

**Expedited Procedure**

**Examining Group 1700**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No. : 10/782,547 Confirmation No. : 3252

Applicants : Larry F. Rhodes et al.

Filed : February 19, 2004

Title : VINYL ADDITION POLYCYCLIC OLEFIN POLYMERS  
PREPARED WITH NON-OLEFINIC CHAIN TRANSFER  
AGENTS AND USES THEREOF

Group Art Unit : 1713

Examiner : Robert D. Harlan

Customer No. : 28289

**MAIL STOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

For the reasons set forth herein, Applicants respectfully submit that the Final Action is based upon improper rejections of the claims and does not establish the asserted *prima facie* case of anticipation based on the cited reference.

- I. Rejection of claims 1-41, 61, 63, 65 and 67, under 35 U.S.C. §102(a)  
as being anticipated by U.S. Patent No. 6,372,869 to Arthur et al.

The Final Action fails to identify where the prior art Arthur et al. patent (hereinafter "Arthur") teaches specific limitations which are present in the claims, resulting in a clear deficiency in the *prima facie* case in support of the rejection.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 8, 2006.

\_\_\_\_\_  
Jennifer L. Halkias

(Name of Person Mailing Paper or Fee)

Jennifer L. Halkias  
Signature

06/08/06  
Date

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Independent claim 1 clearly recites “adding a polymerization catalyst containing Ni and/or Pd ligated by a **monodentate ligand**, the catalyst causing the mixture to polymerize....” (emphasis added). Arthur does not in any way teach or suggest such a claim limitation.

As opposed to a polymerization catalyst containing Ni and/or Pd ligated by a monodentate ligand, Arthur only teaches a process for polymerizing polymerizable olefin using as a polymerization catalyst, a complex of a **bidentate** ligand. (emphasis added)

This single purpose and the teachings of Arthur that are directed to such a purpose are unambiguously previewed in the Abstract, which states: “[t]he molecular weight of polyolefins produced using selected late transition metal complexes of **bidentate** ligands may be lowered by carrying out the polymerization in the presence of hydrogen, a selected silane, or CBr<sub>4</sub>. (emphasis added)

In rejecting the claims, the Final Office Action contends at pages 2-3 that “Arthur further teaches the use of Ni metal catalyst formed by contacting mono-dentate ligands with Ni. See Arthur, Example XII”. (In two telephone conversations with the Examiner conducted with Bernard Berman, Esq., it was pointed out by Mr. Berman, and recognized by the Examiner, that the correct structure the Examiner meant to refer to in the Office Action is formula XI, not formula XII, at column 2 of Arthur.) Such a contention is in opposition to the clear statements of Arthur. For example, Arthur states, at col. 1, lines 48-51, that:

This invention concerns, a process for the polymerization of a polymerizable olefin using as a polymerization catalyst a complex of a **bidentate** ligand of a metal selected from the group consisting of nickel, iron, and cobalt, wherein the improvement comprises, using as a chain transfer agent an effective amount of hydrogen, CBr<sub>4</sub> or a compound of the formula R<sup>1</sup>R<sup>2</sup>R<sup>3</sup>SiH, wherein R<sup>1</sup> is alkyl containing 2 or more carbon atoms, R<sup>2</sup> is alkyl, and R is hydrogen or alkyl (emphasis added).

Continuing from the above, Arthur further states, **ibid**, lines 57-67, that:

This invention also concerns a process for the polymerization of one or more polymerizable olefins, comprising, contacting:  
(a) one or more polymerizable olefins;

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(b) an effective amount of a chain transfer agent selected from the group consisting of hydrogen,  $\text{CBr}_4$  and a compound of the formula  $\text{R}^1\text{R}^2\text{R}^3\text{SiH}$ , wherein  $\text{R}^1$  is alkyl,  $\text{R}^2$  is alkyl, and  $\text{R}^3$  is hydrogen or alkyl;

(c) an active polymerization catalyst which contains a nickel complex of a ligand of the formula....

Arthur then immediately proceeds to list thirty structures, one being formula XI. The listing of the thirty structures immediately following the above-cited disclosures of Arthur must, therefore, be a listing of bidentate, not monodentate ligands as the entirety of Arthur is silent with respect to monodentate ligands.

Based on the above-cited disclosures of Arthur, it is clear that Arthur is directed **only to bidentate ligands**. Indeed, the specification is silent with respect to the use of monodentate ligands of a metal as a polymerization catalyst. The Final Office Action, therefore, is in error in contending that Arthur teaches the use of a Ni metal catalyst formed by contacting monodentate ligands with Ni. Because Arthur does not teach the specific limitation recited in claim 1 of using monodentate ligands of a metal as a polymerization catalyst, it cannot be deemed, under 35 U.S.C. § 102(a), to anticipate claim 1. Pending claims 2-41, 61, 63, 65 and 67 depend either directly or indirectly on claim 1, and thus also are not anticipated by Arthur. As such, a *prima facie* case has not been established, in that specific limitations of the claims are not set forth as being present in Arthur. Further, as Arthur does not teach or suggest the use of Ni and/or Pd catalysts bound to monodentate ligands, claims 1-41, 61, 63, 65 and 67 cannot be obvious in view of Arthur.

Based on these remarks, a *prima facie* case in support of the rejection of independent claim 1 and its respective dependent claims 2-41, 61, 63, 65 and 67, as being anticipated by Arthur has not been met, and the rejection should be withdrawn as improper.

**II. Conclusion**

Based upon the above specified clear error, Applicants assert that a *prima facie* rejection based on anticipation has not been established. It is therefore respectfully requested that the final rejection be withdrawn and reversed and claims 1-41, 61, 63, 65 and 67 be allowed.

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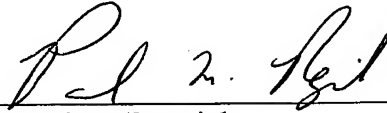
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Any questions regarding this submission should be directed to Applicants' undersigned representative, who can be reached by telephone at 412-471-8815.

Respectfully submitted,

THE WEBB LAW FIRM

By



Paul M. Reznick

Registration No. 33,059

Attorney for Applicants

700 Koppers Building

436 Seventh Avenue

Pittsburgh, Pennsylvania 15219

Telephone: 412-471-8815

Facsimile: 412-471-4094

E-mail: webblaw@webblaw.com